REMARKS

Claims 2-26 are currently pending in the subject application and are presently under consideration. Claim 22 has been amended herein for clarification purposes, and such amendment does not narrow the scope of the claim. Claim 25 has been amended to include limitations of cancelled claim 26 and for clarification purposes. The amendments made herein do not raise new issues requiring further search and/or undue consideration, and therefore entry of such amendments is requested. All pending claims are found at pages 2-5. Favorable consideration of the subject application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 2-21 Under 35 U.S.C. § 103(a)

Claims 2-21 and 25-26 stand rejected under 35 U.S.C. § 103(a) as being obvious over Holland, *et al.* (US 6,507,867) in view of Gauvin *et al.* (US 5,991,760). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. The combination of Holland, *et al.* and Gauvin *et al.* do not teach or suggest applicants' invention as recited in the subject claims. In particular, Holland, *et al.* does not teach or suggest various claimed features of applicants' invention (let alone it teaching away from the invention), and Gauvin *et al.* does not make up for the deficiencies noted *infra* of Holland, *et al.* Moreover, it appears the Examiner is impermissibly effecting the purported combination via employment of applicants' specification as a 20/20 hindsight-based roadmap to make the combination, and also neglecting that the references fail to provide the motivation therein to make the combination but also that Holland, *et al.* teaches away from the invention.

> To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on

applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Independent claims 3, 11, 18 and 21 recite similar limitations regarding executing at least a portion of network-based application at a client *via* loading relevant portions of the application logic from a ***local storage medium*** and a server, ***mapping*** local requests to the logic, locally servicing the requests with the logic, and ***servicing remote requests*** on the server with application ***logic residing on the server***. Likewise, independent claim 25 recites ... a ***request is satisfied by both the client and the server that are concurrently servicing respective portions of the request.*** Holland, *et al.* does not teach or suggest such aspects of applicants' claimed invention. Instead, Holland, *et al.* teaches downloading requested web pages and, if available, associated pages, files and/or executable code, ***from a server*** (not a local storage medium) to a workstation to ***locally service*** web requests with ***locally stored*** information.

In particular, Holland, *et al.* does not teach or suggest providing relevant portions of application logic to a client *via* a ***local storage medium***, as claimed in the subject invention. Instead, Holland, *et al.* teaches downloading requested web pages and related information from ***a remote server bank***. As disclosed, Holland, *et al.* teaches web page requests are transmitted to a web server wherein one or more ***server-side page repositories*** (repository 310, 410) are accessed to retrieve the requested web page and "***all***" pages and files referenced in the requested web page. (*See* col. 14, lines 41-43). A bundle is then constructed, downloaded and stored, and locally utilized. Holland, *et al.* does disclose loading client-side ***server software*** from a storage medium to the workstation; however, such software pertains to the software to interface the client and server, and ***not*** the requested pages, files and/or code bundled, downloaded and accessed from the client. (*See* col. 8, lines 38-55). Hence, the web pages and associated data that are accessed on the workstation to service requests are remotely ***downloaded from the server***. In contrast, the claimed invention recites that the application logic stored on the client to service requests can be provided *via* a ***CD*** and/or ***floppy disk***. (*See* page 6, lines 9-10; page 7, lines 4-5; page 18, lines 9-11). Thus, Holland, *et al.* does not teach or suggest providing application logic to a client *via* a local storage medium, as recited in the subject claims, but merely employs data downloaded from a ***server-side page repository*** to service requests.

In addition, Holland, *et al.* does not teach or suggest ***mapping requests to portions of application logic*** residing on a workstation, as recited in the claimed invention. (*See* page 8, lines 21-25; page 18, lines 1-12). At most, Holland, *et al.* teaches an ***index to correlate a web page with a bundle***, wherein the index provides a technique to locate a locally stored bundle in order to store bundles rather than pages, files and/or code on the workstation. (*See* page 12, lines 4-16; page 14, lines 62-65). Accordingly, Holland, *et al.* does not teach or suggest mapping local request to loaded application logic, as recited in the subject claims, but instead teaches indexes that provide associations to locally stored *bundles.*

Furthermore, Holland, *et al.* does not teach or suggest employing the ***server to execute application logic to service remote requests***, as recited in the subject claims. As noted *supra*, Holland, *et al.* teaches downloading (*e.g.*, *via* a bundle) requested web pages and any associated data from the server to a workstation in order *to service requests with data stored locally* on the workstation ***rather than through the server***. Holland, *et al.* discloses that whenever a user transmits a web page request, a client-side server 460 associated with a workstation 470 determines whether the web page and associated data is stored on the workstation 470, and if not, a bundle request is transmitted to a server 440 to invoke the creation of a bundle comprising the requested information. The bundle is downloaded and stored on the workstation, and then the *locally stored* data is provided to the user to fulfill the request. (*See* col. 9, line 53 - col. 13 line 2; Fig. 4A-B). In contrast, the claimed invention recites execution of application logic residing on the server in response to remote requests. As disclosed, a server component (guarded tier 44) can include and execute application logic to service a remote request 56 from a client (presentation tier 24) at the server. (*See* page 25, lines 27-29). Therefore, not only does Holland, *et al.* fail to teach or suggest executing application logic on a server to service requests, as claimed in the subject claims, but Holland, *et al.* teaches techniques that inherently teach away from employing a server to service requests since requested data is always *downloaded to the workstation prior to being accessed.*

Moreover, Holland, *et al.* teaches an embedded *client-side sever* (a scaled down web server) "***must***" be installed on the *workstation* to request and retrieve bundled web pages, and associated pages, files and code. (*See* column page 5, lines 16-19 and 26-29). In contrast, the claimed invention executes application logic associated with a network-based application on a client ***without*** having to install ***a network server on the client.*** (*See* page 5, lines 12-14).

Gauvin *et al.* does not make up for the aforementioned deficiencies of Holland, *et al.* Rather, Gauvin *et al.* simply teaches techniques for modifying (updating) remotely stored documents using a web browser. In particular, when disconnected a local copy of a document may be accessed and modified through a client browser in a manner similar to when the client was connected to a network. *See e.g.*, col. 2, lines 15-28; col. 5, lines 50-56; col. 6, line 17-col. 7, line 9;and col. 8, lines 12-19. It is readily apparent that Gauvin *et al.* is directed to updating remotely stored documents in connection with client computers being disconnected from and reconnected to a network.

The combination of Holland, *et al.* and Gauvin *et al.* clearly does not teach or suggest identifying relevant portions of application logic required to service a local request and downloading respectively portions of the application logic from a local storage medium and a server as part of a multi-tiered based network architecture to facilitate improved network/system operations as in the claimed invention. The prior art items themselves must suggest the desirability and thus the obviousness of making the combination without the slightest recourse to the teachings of the patent or application. Without such independent suggestion, the prior art is to be considered merely to be inviting unguided and speculative experimentation which is not the standard with which obviousness is determined. *Amgen, Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989); *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988); *Hodosh v. Block Drug*, 786 F2f at 1143 n. 5., 229 USPQ at 187 n. 4.; *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1985). In general, the rationale proffered to combine such teachings is to achieve benefits identified in applicants' specification, to overcome problems associated with conventional methods. Applicants' representative respectfully submits that this is an unacceptable and improper basis for a rejection under 35 U.S.C. §103. In essence, the Examiner is basing the rejection on the assertion that it would have been obvious to do something not suggested in the art because so doing would provide advantages stated in applicants' specification. This sort of rationale has been condemned by the CAFC. *See*, for example, *Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987).

In view of the foregoing, it is respectfully submitted that the rejection of independent claims 3, 11, 18 and 21 (and claims 2, 4-10, 12-17, and 19-20, which respectively depend therefrom) be withdrawn.

II. Rejection of Claims 22-24 Under 35 U.S.C. § 102(e)

Claims 22-24 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Gauvin *et al.* (US 5,991,760). Withdrawal of this rejection is respectfully requested for at least the following reasons. Gauvin *et al.* does not teach each and every limitation of applicants' invention as recited in the subject claims.

> A single prior art reference anticipates a patent claim only if it expressly or inherently describes each and every limitation set forth in the patent claim. *Trintec Industries, Inc., v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 U.S.P.Q.2D 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 22 recites ... ***concurrently*** retrieving ***respective portions*** of an application from ***a local and a remote storage medium***, and executing the portions of the application in connection with a transaction .... As noted *supra*, Gauvin *et al.* is directed to updating remote documents upon disconnect and reconnect to a network. The cited reference does not teach or suggest concurrently retrieving respecting portions of an application from both a local and a remote storage medium as part of a multi-tiered architecture to facilitate network/system operations *via* employment of a client to dynamically offload particular portions of servicing a request from a server as in applicants' claimed invention.

Gauvin *et al.* does not anticipate or make obvious the subject claimed invention, and this rejection should be withdrawn.

CONCLUSION

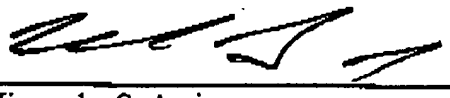
The present application is believed to be in condition for allowance, in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin
Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731